

Appl. No. 10/785,459
Admt. dated December 23, 2004
Response to Office Action of June 24, 2004

REMARKS

Reconsideration of this application in view of the above amendments and following remarks is respectfully requested. Claims 21-22 are now pending. Claims 23 and 24 have been canceled. No new matter has been added. For purposes of clarity, Applicant addresses each of the Examiner's concerns in the order set forth in the Office Action.

Claim Rejection – 35 U.S.C. § 103

Claims 21-22 currently stand rejected under 35 U.S.C. § 103 as being obvious in view of U.S. Patent No. 6,479,560 to Freitag *et al.* and U.S. Patent No. 4,836,552 to Puckett *et al.* In this regard, the Examiner notes that Freitag *et al.* discloses a foaming composition that comprises an ethylene-vinyl acetate copolymer, a thermoplastic elastomer (including a styrene tri-block copolymer), and a blowing agent. The Examiner goes on to recognize that this foaming composition may be used for a number of purposes (such uses include such things as thermal insulation, packaging, footware, gaskets, etc.). The Examiner acknowledges, however, that Freitag et al. does not explicitly disclose that the foaming composition may be used within a golf ball. In order to overcome this shortcoming, the Examiner relies on the disclosure of Puckett *et al.*, presumably because this reference is also made from a foaming composition (albeit a very dissimilar type of foaming composition). Applicant respectfully disagrees with the Examiner's legal conclusion of obviousness because there is no teaching or suggestion in either reference, alone or in combination, that would encourage one of ordinary skill in the art to arrive at Applicant's claimed invention. Accordingly, Applicant traverses this ground of rejection.

As a matter of law, Applicant respectfully notes that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill of the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Because the Examiner has failed to establish that requisite

Appl. No. 10/785,459

Admt. dated December 23, 2004

Response to Office Action of June 24, 2004

suggestion or motivation (to modify the references or to combine reference teachings) in the prior art of record, the present obviousness rejection is inappropriate and must be withdrawn.

Indeed, and as the Examiner acknowledges, Freitag *et al.* does not explicitly disclose that its foaming composition may be used within a golf ball. Moreover, there is no teaching or suggestion whatsoever in Freitag *et al.* that lends credibility to the assertion that its foaming composition would be useful within a golf ball of unitary molded construction, wherein the entire golf ball is foamed from a composition that comprises an ethylene-vinyl acetate copolymer, a thermoplastic elastomer, and a blowing agent. On the contrary, Freitag *et al.* explicitly teaches that its composition may be used in a wide array of end-uses such as, for example:

thermal insulation such as appliances, e.g., refrigerators, hot water heaters, etc; aircraft; commercial or residential construction such as spray or rigid insulation for walls, doors, cavity/widow sealant, acoustical control, etc.; packing material, e.g., foam-in-place; marine foams; environmental control, e.g., spill containment; footware; furniture; toy and consumer goods; protective equipment such as pads, helmets, etc.; fluid filtration; transportation industry uses, e.g., sound dampeners, structural supporting material, etc. for cars, trucks and heavy duty vehicles; vehicle repair; gasketing material; medical uses such as casts, emergency immobilization, etc.; artistic medium such as decorative brick/block, figures, etc.

U.S. Patent No. 6,479,560, col. 2, lines 27-42.

None of the “end-uses” identified in Freitag *et al.* are in anyway similar to an end-use as a unitary golf ball. Thus, there is no teaching or suggestion of the presently claimed invention.

In addition, Puckett *et al.* does not anyway provide the requisite teaching or suggestion because its preferred thermoplastic material is Surlyn (a very dissimilar material) combined with “glass bubbles.” In view of the narrow teachings of Puckett *et al.*, one of ordinary skill in the art would not be motivated to use the foaming compositions of Freitag *et al.* to make a golf ball of unitary molded construction as presently. Accordingly, and in view of the foregoing, Applicant respectfully requests that the Examiner’s obviousness rejection be withdrawn.

Appl. No. 10/785,459
Admt. dated December 23, 2004
Response to Office Action of June 24, 2004

Claim Rejection – Statutory Double Patenting

The Examiner has rejected claims 23 and 24 under 35 U.S.C. § 101 as claiming the same invention as that of claims 11 and 18 of U.S. Patent No. 6,726,577. For purposes of expediting allowance, Applicant has elected to cancel claims 23 and 24 without prejudice. Accordingly, Applicant respectfully requests that this ground of rejection be withdrawn.

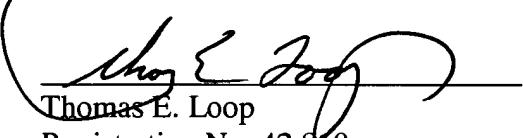
Claim Rejection – Statutory Double Patenting

The Examiner has rejected claims 21 and 22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8 of U.S. Patent No. 6,726,577. In order to obviate this ground of rejection, Applicant concurrently submits herewith an appropriate Terminal Disclaimer signed by the registered attorney of record.

In view of the above amendments and remarks allowance of claims 21 and 22 is earnestly solicited. A good faith effort has been made to place this application in condition for allowance. If any further matter requires attention prior to allowance, the Examiner is respectfully requested to contact the undersigned attorney at (206) 568-3100 to resolve the same.

Respectfully submitted,

~~BARNARD, LOOP & McCORMACK LLP~~


Thomas E. Loop
Registration No. 42,810
P.O. Box 21466
Seattle, WA 98111
(206) 568-3100 phone
(206) 568-3168 fax